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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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087,213,791

12-15-98

ALPORN

6

88,104,116

EDMOND'S

HMU 070354

PENNIE AND EDMOND'S

1151 AVENUE OF THE AMERICANS

NEW YORK, NY 10036-2711

EXAMINER

SCHMIDT, J. H.

ART UNIT

PAPER NUMBER

1695

DATE MAILED:

03/30/99

*Restarted* } *Restarted*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

01/21/97

Applicant(s)

Hercules

Examiner

J. L. Smith

Group Art Unit

1656

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

X Claim(s) 1-15

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

Claim(s)

is/are allowed.

X Claim(s) 1-17

is/are rejected.

Claim(s)

is/are objected to.

Claim(s)

are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is approved \_\_\_\_\_ disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some\* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number)

received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received:

### Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s).

Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

X Other Notice To Comply w/ Sequence Rules

Office Action Summary

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### **DETAILED ACTION**

1 This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19 are indefinite for the language "capable of" since such language defines a latent characteristic of the claimed invention, the metes and bounds of which are not clear.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)

4. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,849,902. Although the conflicting claims are not identical, they are not patentably distinct from each other.

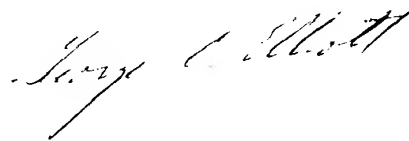
The instant claims differ from the claims of '902 since the instant claims specify the 11-59 bases are divided by an Rnase H-activating region and the claims of '902 specify the 5' terminal or 3' terminal of the oligonucleotide is attached to the an Rnase -H activating region. Absent evidence to the contrary, it would have been obvious to one of ordinary skill in the art that Rnase H functions by recognizing and cleaving RNA/DNA duplexes and said activation region of '902 would render obvious its application anywhere in an oligonucleotide.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "George C. Elliott".

George C. Elliott, Ph.D.  
Supervisory Patent Examiner  
Technology Center 1600

M. M. Schmidt  
March 26, 2000